

U.S. Application No.: 09/909,038
AMENDMENT B

AFTER FINAL
Attorney Docket: 3975.003

REMARKS

Claims 10-17 are pending. No claim is amended, canceled or added herein.

The specification is amended herein at paragraphs 8-12, 25, 26, 28, 31, 33, 35 and 38, based upon the specification as filed. Care has been taken to ensure that no new matter is added to the specification.

Entry of the amendments and reconsideration in view of the following remarks is respectfully requested.

Foreign Priority

The Examiner notes, on the Office Action Summary, that only some of the "Certified copies of the priority documents have been received."

Applicant notes that this application claims priority from July 20, 2000, based upon German Application No. 100 37 166.3, and that a certified copy of the priority document was provided in the Response to Notice To File Missing Parts, which was filed on September 18, 2001.

The Examiner is respectfully requested to identify any remaining steps required to perfect the claim for priority.

Objections to the Disclosure

The disclosure is objected to for a number of informalities. Applicants assert that the amendments to the specification fully address any such informalities.

Paragraphs [0008]-[00012] are amended to delete their respective paragraph numbers, thereby recombining these text portions into a single paragraph [0007]. Support for this amendment is found in the punctuation of paragraphs [0007]-[00012], which indicates that they comprise a single paragraph.

Similarly, paragraphs [00024] and [00025] are amended to delete their respective paragraph numbers, thereby recombining the brief description of the drawings into a list beginning at paragraph [00024].

Paragraphs [00031], [00033], [00035] and [00038] are amended to include a terminal period.

Paragraphs [00025] and [00028] are amended to delete the translator's parenthetical comments, with deference to the translator's preferred translation, and based upon the specification as filed.

Accordingly, withdrawal of the objections to the disclosure is respectfully requested.

Rejections under 35 U.S.C. §103

Claims 10-17 are rejected as being allegedly unpatentable for obviousness over Wolf et al. (USPTO English translation of WO 00/15341), published on March 23, 2000.

Applicants respectfully traverse the rejection on two grounds.

First, Applicants assert a date of invention at least prior to January 9, 2000, which is prior to the effective date of Wolf et al. (WO 00/15341) as a reference (March 23, 2000).

Applicants submit herewith a publication ("An evolutionary approach in the combinatorial selection and optimization of catalytic materials" Applied Catalysis A: General 200 (2000) pp. 63-77, D. Wolf, O. V. Buyevskaya and M. Baerns), which was submitted for publication on January 9, 2000 and was published on August 28, 2000. This reference teaches the improved method that is the subject of the instant application, and thereby establishes a date of invention that is prior to the effective date of Wolf et al. (WO 00/15341) as applied in the present rejection.

Applicants will forward an executed Declaration under 37 C.F.R. § 1.131 in support as soon as it is available.

In view of the earlier date of invention, Applicants assert that Wolf et al. (WO 00/15341) is not valid prior art under any section of 35 U.S.C. § 102, and respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn.

Second, Applicants assert in the alternative that even if, arguendo, Wolf et al. were prior art, which Applicants expressly do not admit, Wolf et al. does not render the present invention obvious.

The instant invention represents a non-obvious improvement over the method for production of new catalysts as taught in Wolf et al. (WO 00/15341). As set forth at, for example, paragraphs [0002] of the instant specification, the method taught in DE 198 43 249.2, which is in the same patent family as Wolf et al. (WO 00/15341), suffers from the drawback that components required to produce an optimal catalyst may be lost

in the first or subsequent generations, resulting in the production of a non-optimal catalyst. As set forth at paragraphs [0004] and [0005] of the instant specification, the presently claimed invention addresses this deficiency by increasing the representation of materials that would otherwise be discarded. Steps (iv) and (v) of claim 10 achieve this goal by the process of crossing, whereby a component that is present in only one of two catalysts is not lost. Similarly, step (viii) of claim 10 may add an absent component through the process of mutation. Claims 11-17 depend directly or indirectly from claim 10.

The above-mentioned steps of claim 10 avoid the premature loss of components that may be required to produce an optimal catalyst. However, neither these steps, nor the desireability of preventing premature loss of components, are taught or suggested by Wolf et al. (WO 00/15341). Accordingly, Wolf et al. (a) fails to teach all of the elements of the rejected claims, (b) fails to provide a motivation to adapt the method therein to arrive at the present invention, and (c) provides no reasonable expectation of success in doing so. Therefore, Applicants assert that a *prima facie* case of obviousness has not been established, and respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn.

As there are no further objections or rejections, reconsideration and the early issuance of a Notice of Allowance is solicited. If the Examiner believes that any further issues

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remain that may be addressed by telephone, the Examiner is requested to contact the undersigned at the number below.

Respectfully submitted,

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CERTIFICATE OF MAILING AND AUTHORIZATION TO CHARGE

I hereby certify that the foregoing AMENDMENT B for U.S. Application No. 09/909,038 filed July 19, 2001, were deposited in first class U.S. mail, postage prepaid, addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on **July 6, 2004**.

The Commissioner is hereby authorized to charge any additional fees that may be required at any time during the prosecution of this application, except for the issue fee, without specific authorization, or credit any overpayment, to Deposit Account No. 16-0877.



Christopher J. Kay